

#### REMARKS

Responsive to the Office Action, Applicants affirm the election of Claims 1 through 26 for further prosecution of this application. Claims 27 and 28 have been canceled.

In the Office Action the Examiner objected to the specification with regard to the incorrect recitation of U.S. Patent 5,961,150. Replacement pages 1 and 2 of the specification are submitted herewith showing the correct patent number. A corrected Abstract of the Disclosure is submitted herewith including a word count of less than 150 words. Marked up copies of the corrected pages of the specification are attached to this amendment.

In the Office Action, the Examiner rejected Claims 1 through 26 under 35 U.S.C. 112. Applicants present with this amendment amended independent Claims 1 and 17 which have been amended to overcome the rejection of the claims under 35 U.S.C. 112 and to patentably distinguish over the prior art. The amendments to Claims 1 and 17 are believed to place these claims in conformance with the requirements of 35 U.S.C. 112.

With regard to the rejection of Claim 11 under 35 U.S.C. 112, this claim has been amended to eliminate possible ambiguities therein.

Dependent Claims 22, 23, 25 and 26 have been amended to provide proper antecedent basis for terms therein in view of amendments to Claim 17.

Responsive to the rejections of the original claims presented in this application under 35 U.S.C. 102(b), 102(e) and 103(a), Applicants have thoroughly reviewed the claims in light of the prior art cited by the Examiner and, consequently, have canceled Claims 3 through 7. Independent Claim 1 has been amended to include the recitation, essentially, of original Claims 1, 3, 4 and 5. Claim 17 has been amended, generally along the lines of the amendments to Claim 1. New independent Claims 29 and 30 are presented herewith and are based on the combinations of Claims 1, 3, 4 and 6 and 1, 3, 4 and 7, respectively. Claims 2 and 8 through 16 remain in the application dependent on amended Claim 1 and Claims 18 through

26 remain in the application dependent on amended Claim 17. Consideration for allowance of the claims currently pending in this application is requested for the cogent reasons set forth hereinbelow.

Applicants have amended Claims 1 and 17 and present Claims 29 and 30 directed specifically to a method for making an article comprising one of a portfolio, desk folder, binder, wallet, luggage tag, memo pad or key fob wherein the article includes a member formed of a flexible material comprising at least a portion of a cover part of the article. Claims 1 and 17 as originally presented were directed to a method of making an article, such as a folder or portfolio and the claims were characterized as such with a view to encompassing all of a variety of articles generally known in the art as business accessory articles or promotional articles. At the onset, Applicants wish to make clear that the method set forth in the claims is directed to the manufacture of such types of articles. Business accessory articles of the type characterized by Claims 1, 17, 29 and 30 are normally manufactured in relatively large quantities pursuant to orders placed by customers who wish to have a particular graphic image placed on the article in a conspicuous location including a cover part of the article, the graphic image being specific to a particular product or service brand name or to, possibly, commemorate an event, such as a trade convention or seminar. Such articles are usually ordered in relatively large quantities on short notice based on the needs of the customer and, of course, each graphic image is different from one customer, or one order, to the next. Accordingly, a manufacturer of such articles would realize the need to develop a fast and cost efficient process, which has been the objective of the invention set forth in the claims initially presented and now presented pursuant to the amendments to Claims 1 and 17, in particular.

With regard to the rejections of the claims, even though such claims were initially, and are now directed to business accessory articles of manufacture, such as a folder or portfolio, it is noted that the prior art cited in the

rejections is somewhat diverse and none of the references are directed to the art of making the particular type of article disclosed in Applicants' specification, and as set forth in the claims. Thus, Applicants verily believe that one skilled in the art of manufacturing business accessory articles, such as portfolios or desk folders which are formed of flexible leather-like materials would not look to nor be charged with knowing the art of paper label manufacture, plastic tile manufacture or identification card manufacture in order to develop the inventive processes set forth in Claims 1, 17, 29 and 30 and the claims dependent thereon, respectively.

Applicants present with this amendment amended Claim 1 which includes, essentially, the recitation of Claims 1, 3, 4 and 5. In particular, Claim 1 now recites a method of making an article comprising one of a portfolio, desk folder . . . . ., which includes the steps of bonding an image sheet to a member forming a portion of a cover part of the article by pressing the image sheet to the member and applying RF energy to adhere the image sheet to the member and debossing the member to form an indentation therein while bonding the image sheet to the member in the indentation. In this way the flexible material image sheet is adhered to the flexible cover member of the article at an indentation so that the image sheet is less susceptible to being inadvertently scuffed or peeled away from the cover member in subsequent use of the article. Moreover, the step of adhering the image sheet to the cover member of the article while forming the indentation is carried out substantially simultaneously. In at least these respects the method set forth in Claim 1 of making a business accessory article comprising a portfolio, desk folder or the like, is believed to be patentably distinct.

In the Office Action the Examiner rejected Claim 5 under 35 U.S.C. 103(a) over the teaching of U.S. Patent 5,974,230 to Jenkins in view of U.S. Patent 4,477,013 to Herrin and U.S. Patent 5,891,552 to Lu et al and further in view of U.S. Patent 4,778,547 to Becker et al. With regard to the Jenkins reference, this patent discloses a method for making labels for

file folders wherein a sheet of multiple labels is printed, a vinyl cover sheet having a pressure sensitive adhesive backing is laminated to the printed label sheet and then labels are die cut before being applied to file folders. With regard to the teaching of Herrin, this patent is directed to a file folder having a rear panel of paper stock and a front panel of transparent plastic connected to the rear panel with a layer of adhesive. Still further, the patent to Lu et al discloses a process for thermal transfer printing onto plastic films and, lastly, the Becker et al reference discloses a process for making a plastic wall tile or floor tile wherein an embossing step is carried out to adhere a film layer to a base or substrate.

As pointed out above, Applicants respectfully submit that the diverse and somewhat non-analogous arts of the references cited in rejecting Claim 5 are not believed to render this claim obvious in view of the state of the art in the manufacture of business accessory articles, such as portfolios and desk folders. Still further, however, none of the references taken alone, or in combination, or one modified in view of the other, suggest the step of bonding an image sheet to a member of a folder or portfolio by debossing the member to form an indentation therein while bonding the image sheet to the member at the indentation so that the image sheet resides in the indentation and is less susceptible to damage in use. The embossing step described in Becker et al is not analogous to the debossing step set forth in Claim 1, as amended. One skilled in the art would consider "embossing" to be a step which would create a raised portion of the member to which the image sheet is being adhered, but this is not the process set forth in Claim 1, as amended. Embossing does not provide the advantages of the process set forth in Claim 1, as amended. Accordingly, reconsideration for allowance of Claim 1 is respectfully requested.

In the Office Action the Examiner also rejected Claim 5 under 35 U.S.C. 103(a) over the teaching of U.S. Patent 6,319,349 to Lin in view of Becker et al. Lin and Becker et al

are directed to plastic floor tiles and an embossing step may, possibly, be advantageous to provide a textured or roughened surface to improve traction thereon. This is not the purpose of the present invention. The present invention as set forth in Claim 1, as amended, requires debossing so as to provide an indentation and so that the image sheet will reside in such indentation and will be less susceptible to being peeled off the surface of the member to which it has been bonded. The prior art does not suggest this process and Claim 1 is not believed to be obvious in view of the teaching of Lin as modified by Becker et al or vice versa.

Claims 2 and 8 through 16 remain in the application dependent on amended Claim 1 and reconsideration for allowance of these claims is requested at least for the reasons set forth in support of the patentability of Claim 1.

In the Office Action the Examiner rejected Claim 6 under 35 U.S.C. 103(a) as being unpatentable over the teaching of Jenkins, in view of Herrin, Lu et al and Becker et al and further in view of Graphik Vinyl Products Co., 2000 catalog. Claim 6 is presented with this amendment in independent form as Claim 29 and includes recitation of the steps of debossing a member which forms a portion of a cover part of the article set forth in the claim so as to form an indentation therein followed by placing an image sheet having a printed image on the first side and in contact with the member at the indentation at a second and opposite side of the image sheet and then bonding the image sheet to the member at the indentation by pressing the image sheet to the member and applying RF energy to adhere the image sheet to the member.

In at least these respects Claim 29 is believed to be directed to a nonobvious method for making a business accessory article as set forth in the claim. None of the references including Becker et al, or Graphik Vinyl Products, suggest the steps of debossing a member formed of flexible material to form an indentation in the member and then placing an image sheet in contact with the member at the indentation and bonding the image

sheet to the member at the indentation in the manner set forth in Claim 29.

The process set forth in Claim 29 provides an additional advantage in that the indentation formed prior to placement of and bonding of the image sheet to the member provides a guide for placing the image sheet on the member. None of the references applied in the rejection of Claim 6 teach this step, including Graphik Vinyl Products. Although Graphik Vinyl Products discusses debossing and embossing, Graphik Vinyl Products does not disclose or suggest carrying out a debossing step, then placing an image sheet in the indentation formed by the debossing step, then pressing the image sheet to the debossed member and applying RF energy to adhere the image sheet to the member. Accordingly, Applicants respectfully submit that when considering the references cited in rejecting Claim 6 alone or modified one in view of the other, the overall method set forth in new Claim 29 is not made obvious in view of the prior art. Consideration for allowance of Claim 29 is respectfully requested.

In the Office Action the Examiner also rejected Claim 6 under 35 U.S.C. 103(a) over the combined teaching of Lin, Becker et al and Graphik Vinyl Products. Lin and Becker et al are directed to plastic floor tiles which are embossed to provide an anti-slip surface. Graphik Vinyl Products suggests debossing the soft cover of a portfolio or the like but not for placement of an image sheet in contact with the member which has been debossed and at an indentation formed by the debossing step, and then bonding the image sheet to that member at the indentation by pressing the image sheet to the member and applying RF energy. Absent the suggestion in the prior art to carry out a debossing step in the manner recited in Claim 29, this claim is believed to be patentable.

Applicants present with this amendment Claim 7 in independent form as Claim 30. In the Office Action the Examiner rejected Claim 7 under 35 U.S.C. 103(a) as being obvious in view of the teaching of the Jenkins, Herrin, Lu et al and Becker et al references and further in view of U.S. Patent 5,380,044 to

Aitkens et al. . Claim 30 recites the steps in a method of making an article comprising one of a portfolio, desk folder . . . ., of providing a debossing die and placing an image sheet on the debossing die, then placing the member which forms a portion of the cover part of the article in engagement with the image sheet at a side of the image sheet opposite the side on which a printed image has been formed, and then bonding the image sheet to the member by pressing the image sheet and the member together and applying RF energy to adhere the image sheet to the member.

As pointed out hereinabove with regard to the teaching of the combination of references of Jenkins, Herrin, Lu et al and Becker et al, none of these references teach the steps of using a debossing die in the process of adhering an image sheet to a cover part of an article, such as a portfolio or desk folder or the like, as set forth in the claim. With regard to the teaching of Aitkens et al, this patent is also believed to be somewhat non-analogous art in that it is directed to the manufacture of laminated identification cards.

Moreover, with regard to the steps of placing an image sheet on a debossing die and then placing a member in engagement with the image sheet, as set forth in Claim 30, Applicants respectfully submit that Aitkens et al does not suggest such a step. Aitkens does provide a fixture (84) including a jig base (86) and a top plate (96). This structure allows stacking of several cards (12a, 12b and so on) so that the cards can then be inserted into a heated press, not shown in Aitkens et al, where pressure is applied to the jig base and top plate (86 and 96) to laminate the cards. This process is not the same as providing a debossing die and placing an image sheet on the debossing die, followed by placing a member to which the image sheet is to be secured in engagement with the image sheet in the manner required by Claim 30. Modifying the processes of Jenkins, Herrin, Lu et al and Becker et al as suggested by Aitkens et al is verily believed to not make obvious the method of making an article comprising a desk folder or portfolio carried out by the

steps of Claim 30. Consideration for allowance of Claim 30 is respectfully requested.

In the Office Action the Examiner also rejected Claim 7 under 35 U.S.C. 103(a) as being obvious in view of the teaching of the Lin reference in view of Becker et al and Aitkens et al.

As pointed out hereinabove, Claim 30 requires the step of placing the image sheet on the debossing die and then placing the member to which the image sheet is to be bonded in engagement with image sheet, followed by the step of pressing the image sheet and the member together while supported on the debossing die and applying RF energy. These steps are not suggested by the references of record. Neither Lin nor Becker et al suggest the step of placing an image sheet on a debossing die and Aitkens et al does not disclose a debossing die but only a jig for containing a stack of personal identification cards which are to be laminated together by a hot pressing step. The art clearly does not teach the steps set forth in Claim 30 and consideration for allowance of the claim is further requested.

In the Office Action the Examiner rejected Claim 17 under 35 U.S.C. 103(a) over the teaching of the Jenkins, Lu et al, Becker et al and Aitkens et al references. As pointed out hereinabove, this combination of references, none related to the art of forming an article comprising one of a portfolio, desk folder . . . . ., does not disclose or suggest the steps of placing an image sheet in contact with a member which forms a portion of a cover of such an article and bonding the image sheet to the member by engaging the image sheet with a debossing die and applying RF energy to bond the image sheet to such a member.

The Examiner states that Jenkins does not disclose the steps of debossing and bonding the image sheet using RF energy but that such are well known and conventional, as shown by Lu et al, Becker et al and Aitkens et al. However, as pointed out hereinabove, Lu et al is directed to a process for thermal transfer printing onto plastic films for use as plastic labels. Applicants respectfully submit that Lu et al does not suggest bonding an image sheet of flexible plastic material to a member



of flexible material by engaging the image sheet with a debossing die. Lu et al is also directed to a coating composition which enhances the printability of plastic surfaces, such as plastic films, but the thermal transfer printing processes described in Lu et al do not include bonding an image sheet to a member by engaging the image sheet with a debossing die and applying RF energy to bond the image sheet to a flexible member.

With regard to the teaching of Becker et al, Applicants respectfully submit that one would not look to a process for making floor or wall tiles having anti-slip surfaces thereon to provide the method set forth in Claim 17. In fact, modifying a label making process as set forth in Jenkins, using a film composition as suggested by Lu et al, in light of use of an "embossing" die as suggested by Becker et al would not provide the combination set forth in Claim 17.

Still further, as pointed out hereinabove, the Aitkens et al reference does not disclose or suggest a process involving a debossing die. The jig (84, 86, 96) used to hold or align multiple ID cards, while a laminating process is being carried out on the cards in a stack, does not comprise or suggest the step of engaging an image sheet with a debossing die and applying RF energy to bond an image sheet to a member of an article in accordance with Applicants' invention.

In the Office Action the Examiner also rejected Claim 17 under 35 U.S.C. 103 over the teaching of Lin in view of Becker et al and Aitkens et al. Applicants respectfully submit that the Lin reference suffers from the same deficiency as substantially all of the art of record in this application, namely that it is directed to a process of preparation of a plastic floor tile and not to an article as set forth in Claim 17. Although Lin discloses a process for making a plastic tile which includes a so-called skin layer having a pattern or image formed thereon, Lin teaches bonding the skin layer to a PVC substrate with an embossed anti-slip surface by hot pressing or calendaring, the latter process requiring movement of the article between calendaring roll members. This process is not the same as, nor

does it make obvious, a method including the steps of engaging an image sheet with a debossing die and applying RF energy to bond the image sheet to a cover portion of an article such as a portfolio or desk folder, for example.

Still further, as pointed out hereinabove, with regard to the teaching of Becker et al, this reference also discloses an embossing step for forming a plastic floor or wall tile. Moreover, Aitkens et al is devoid of suggesting bonding an image sheet to a member forming part of a cover of an article, such as a portfolio or desk folder, by engaging the image sheet with a debossing die and the application of RF energy. Reconsideration for allowance of Claim 17 is further requested in that the prior art of record in this application fails to disclose or make obvious the overall combination of steps for making an article as claimed.

Claims 18 through 26 remain in the application dependent on amended Claim 17. With regard to Claim 18, Applicants respectfully submit that the teachings of Jenkins, Lu et al, Becker et al, Aitkens et al and Graphik Vinyl Products, taken alone or in combination, fail to disclose or suggest the step of debossing a member of flexible material to form an indentation which provides a guide for locating an image sheet on the member prior to placement of the image sheet in contact with the member and then bonding the member to the image sheet with a debossing die. As pointed out hereinabove, even though Graphik Vinyl Products broadly discloses that soft cover portfolios may be debossed, there is clearly no suggestion to use a debossing step as a step which provides a guide for locating an image sheet followed by the step of engaging the image sheet with a debossing die and applying RF energy to bond the image sheet to the member which was previously debossed. Reconsideration for allowance of Claim 18 is requested.

Reconsideration for allowance of Claim 19 is requested. Applicants respectfully submit that none of the references including Jenkins, Lu et al, Becker et al and Aitkens et al or the combination of Lin, Becker et al and Aitkens et al disclose or suggest the step of placing an image sheet on a debossing die

and then placing a member to which the image sheet is to be bonded over the image sheet prior to bonding the image sheet to the member. The accurate placement of an image sheet on a member of an article of the type set forth in the claims in this application and the avoidance of misalignment of the image sheet with the debossing die is not addressed by the prior art in any manner. Applicants respectfully submit that Aitkens et al does not disclose that a debossing die can be placed on the top and bottom of the pressing jig (84, 86, 89) to provide the process set forth in Claim 19. Aitkens et al clearly does not disclose or suggest the provision of a debossing die in any form.

Applicants request reconsideration for allowance of Claim 20. In the Office Action the Examiner states it would be logical to one skilled in the art to provide a guiding device on a folder or substrate to properly align an image sheet onto the substrate. However, the prior art of record in this application is devoid of such teaching or suggestion. Whereas it may be, in retrospect, deemed logical to provide a guiding device for accurate placement of an image sheet, there is no suggestion in the art of record to provide this step and reconsideration for allowance of Claim 20 is requested.

With regard to Claim 21, the step of directing a light beam onto a predetermined location on the member to which the image sheet is to be applied is also not disclosed or suggested by the prior art. The logic of carrying out such a step is not disputed. However, the prior art is devoid of any teaching of the step. Reconsideration for allowance of Claim 21 is requested.

Reconsideration for allowance of Claims 22 through 26 is requested at least for the reasons set forth above in support of the patentability of Claim 17. With regard to Claim 24, in particular, the step of debossing the member to which the image sheet is to be applied to form an indentation therein while bonding the image sheet to the member is clearly not disclosed or suggested by the prior art of record. The prior art discloses embossing but not the provision of an indentation in the member which is to receive the image sheet. The only

reference to debossing is set forth in Graphik Vinyl Products but the art does not suggest the overall combination of steps set forth in Claims 17 and 24. Reconsideration for allowance of Claims 22 through 26 is requested.

Applicants have made a diligent effort to advance the prosecution of this application by canceling claims, amending claims to clearly define over the prior art and to conform to the requirements of 35 U.S.C. 112 and by pointing out with particularity herein how the claims now presented distinguish in a patentable sense. An early Notice of Allowance of Claims 1, 2, 8 through 26, 29 and 30 is respectfully solicited.

Respectfully submitted,

Date: Sept 3, 2002

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Serial No. 09/656,258  
Group 1734  
Examiner: CHAN, SING P.

MARKED UP SPECIFICATION PAGES, ABSTRACT  
OF THE DISCLOSURE AND AMENDED CLAIMS  
(AMENDMENT A)

Attorney Docket  
No. 125447-1004

[IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
SPECIFICATION  
Accompanying

Application for Grant of U.S. Letters Patent]

TITLE: BUSINESS ACCESSORY ARTICLE WITH GRAPHIC IMAGE AND  
METHOD OF MAKING

FIELD OF THE INVENTION

The present invention pertains to an article of manufacture, such as a portfolio, desk folder, ring binder, wallet or similar business accessory article having an improved graphic image printed thereon by an image transfer process which includes transferring the image from a source image to a sheet of flexible material, such as vinyl, providing a protective coating or laminate over the image and adhering the image sheet to the article which may include a debossing operation.

BACKGROUND

Business accessory and gift articles, such as portfolios, desk folders, ring binders, wallets, luggage tags, keyfobs, memo pads and similar articles, are typically fabricated of a soft, durable material such as fabrics, vinyl, leather or other synthetic leather-like materials. The application of ornamental designs with graphic images or other pictorial features on the surface of the leather or synthetic leather-

like material of the article is important and certain developments in the production of promotional and gift articles of the general type discussed above have been carried out. US Patents 5,762,375 and [5,961,140] 5,961,150, both to Randy A. Kogutt and Michael A. Kogutt, and assigned to the assignee of the present invention, are directed to important advancements in the art of manufacturing articles of the type described herein. The subject matter of both of the above-mentioned patents is incorporated herein by reference in its entirety.

The above mentioned patents provide an article having a graphic image disposed in a "window" of the cover or other outer surface, for example, of an article such as a desk folder or portfolio as described in detail in the patents. However, such a "window" may also be provided as a raised or depressed surface of the material of the article and an image placed in the "window" by providing the image on a separate sheet of material and adhering the image sheet so provided to the material of the article within the "window". Alternatively, the window may be simultaneously formed with application of a sheet or substrate bearing the image to the material of the article which is to be decorated with the image.

There is also a desire in the manufacture of articles of the type in question to be able to conveniently provide a virtually infinite variety of images to be placed on the article and to make the images aesthetically pleasing and durable as well as economical to produce when applied to relatively large quantities of articles of the type in question. It is to these ends that the present invention has been developed.

#### ABSTRACT OF THE DISCLOSURE

An article [of manufacture] such as a soft cover portfolio, or desk folder[, or similar article,] includes a graphic image [provided] thereon by transferring an image from a source to a processor which is operable to control a printer to print multiple images on a sheet of polyvinyl chloride or the like. The printed images may be protected by laminating a transparent vinyl sheet over the [larger] image sheet and the images are then precut to final size. The [final] individual images [sheets] are applied directly to the article [of manufacture] or to a member [of flexible material to be] used in forming an article [of manufacture] by[, preferably,] RF sealing the image [sheet] to the member [which will form a part of the article]. The [precisely cut] image [sheet] may be supported on a debossing die or placed on the member which will form the article, then struck by the debossing die. [Accurate positioning of the image sheet on the member may be carried out by use of a guide device, focused light beams or by a light debossing operation to form an indentation in the member prior to locating the image sheet on the member. A virtually infinite range of graphic images may be rapidly and permanently placed on members which are then used to form articles of manufacture, such as portfolios, desk folders, luggage tags, memo pads and similar articles in relatively large quantities.]

1. (Amended) A method of making an article[, such as a folder or portfolio, adapted to have] with a printed image thereon, said article comprising one of a portfolio, desk folder, binder, wallet, luggage tag, memo pad or keyfob, said method comprising the steps of:

providing a member [to be formed as or forming] formed of a flexible material and comprising at least a portion of a cover part of said article;

providing an image sheet of a flexible material to be bonded to said member;

printing an image on said image sheet on a first side thereof;

placing said image sheet in contact with said member at a second and opposite side of said image sheet; [and]

bonding said image sheet to said member by pressing said image sheet to said member and applying RF energy to adhere said image sheet to said member; and

debossing said member to form an indentation therein while bonding said image sheet to said member in said indentation.

11. (Amended) The method set forth in claim 10 including the step of:

    providing a textured surface of said image sheet [by one of calendering a surface of said image sheet] prior to applying said coating [and debossing a textured surface] on said image sheet.



17. (Amended) A method of making an article[, such as a folder or portfolio, adapted to have] with a printed image thereon, [the] said article comprising one of a portfolio, desk folder, binder, wallet, luggage tag, memo pad or keyfob, said method comprising the steps of:

providing a member formed of a flexible material and comprising [to be formed as or forming] at least a portion of a cover part of said article;

    providing a sheet of flexible plastic material adapted to be receptive to multiple printed images on one side of said sheet of flexible plastic material;

    transferring an image to be applied to said sheet of flexible plastic material to a processor;

    causing said processor to control a printer for printing multiple images on said sheet of flexible plastic material;

    cutting multiple image sheets from said sheet of [said] flexible plastic material along predetermined contours of said images, respectively;

    placing at least one of said image sheets in contact with said member; and

    bonding said at least one image sheet to said member by engaging said at least one image sheet with a debossing die and applying RF energy to bond said at least one image sheet to said member.

22. (Amended) The method set forth in claim 17 including the step of:

    laminating a flexible transparent sheet onto said sheet of flexible plastic material prior to cutting said image sheets from said sheet of flexible plastic material.

23. (Amended) The method set forth in claim 22 including the step of:

    providing said sheet of flexible plastic material and said transparent sheet of polyvinyl chloride, respectively.

25. (Amended) The method set forth in claim 17 including the step of:

providing said sheet of flexible plastic material and said member of polyvinyl chloride.

26. (Amended) The method set forth in claim 17 including the step of:

applying an ink receptive coating on said sheet of flexible plastic material prior to printing images thereon.

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